

PATENT**Application # 10/622,259****Attorney Docket # 2002P20760US01 (1009-029)****REMARKS**

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 9 and 17 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-32 are now pending in this application. Each of claims 1, 2, 9, 14, 26 is in independent form.

I. Priority

The present Office Action asserts, at Page 2:

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No.

PATENT**Application # 10/622,259****Attorney Docket # 2002P20760US01 (1009-029)**

09/507,479, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior-filed application, now US Patent 6,625,665, does not provide adequate support or enablement for the claim limitations of a Freeport mode or a PPI mode, therefore not enabling the claim limitations of the current application.

This application repeats a substantial portion of prior Application No. 09/507,479, filed 2/17/2000, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Applicant respectfully traverses each of these assertions as legally and factually erroneous.

As an initial matter, Applicant respectfully notes that the referenced "prior-filed application" "now US Patent 6,625,665" has absolutely no relevance to the present application. Further, U.S. Patent No. 6,625,665 was based upon Application No. 09/492,967 and not "Application No. 09/507,479" as asserted by the present Office Action. U.S. Patent No. 6,625,665 lists one Daniel H. McCabe as the sole inventor. "Application No. 09/507,479", yet another irrelevant patent referenced by the present Office Action, issued as U.S. Patent No. 6,625,669, lists one Kent D. Cedola as the sole inventor. By contrast, the present application lists Steven M. Hausman and Temple L. Fulton as inventors. Neither patent 6,625,665 nor 6,625,669 "repeats" any portion whatsoever of the present application and appear to have no relevance whatsoever thereto.

Applicant respectfully submits that the present application claims priority to U.S. Provisional Patent Application Ser. No. 60/436,302. Applicant would respectfully request examination of that document regarding compliance with 35 U.S.C. 120 and/or 37 CFR 1.78 instead of irrelevant documents that have no relation to the present application.

PATENT**Application # 10/622,259****Attorney Docket # 2002P20760US01 (1009-029)**

U.S. Provisional Patent Application Ser. No. 60/436,302 provides support for "Freeport mode" and "PPI mode" at least at pages 3-9 and 17-18. The present Office Action presents no evidence that the disclosure of U.S. Provisional Patent Application Ser. No. 60/436,302 does not comply with 35 U.S.C. 120 and 37 CFR 1.78.

For at least these reasons, a reconsideration and withdrawal of the assertions of the present Office Action regarding the priority date claimed by the present application is respectfully requested.

II. The Obviousness Rejections

Each of claims 1-32 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 5,649,001 ("Thomas"), U.S. Patent No. 2001/0037491 ("Boggs"), U.S. Patent No. 6,978,319 ("Rostoker"), and/or U.S. Patent No. 2003/0167391 ('Al-Ali'). Each of these rejections is respectfully traversed.

A. Legal Standards**1. *Prima Facie* Criteria for an Obviousness Rejection**

Over 40 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham's* required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The United States Supreme Court clarified the obviousness inquiry criteria in *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). The KSR Court held:

PATENT**Application # 10/622,259****Attorney Docket # 2002P20760US01 (1009-029)**

1. “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”;
2. “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”;
3. it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit”; and
4. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

In order to establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh’g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d

PATENT**Application # 10/622,259****Attorney Docket # 2002P20760US01 (1009-029)**

1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'". MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Lack of Evidence of Reasons for Combining References

Under the *Graham* analysis, the "examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must provide evidence that indicates that the combination was obvious to a person with ordinary skill in the art. The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

PATENT**Application # 10/622,259****Attorney Docket # 2002P20760US01 (1009-029)****4. Next Office Action**

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis**1. Claims 1-25****a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Each of independent claims 1, 2, 9, 14, from one of which each of claims 3-8, 10-13, and 15-25 ultimately depends, states, *inter alia*, yet the applied portions of Boggs do not teach, “said programmable cable adapted to store” “a plurality of configuration parameters”, that comprise “a mode switch parameter adapted to cause a mode switch of said programmable cable to select between a Freeport mode and a PPI mode”. The applied portions of Boggs do not teach any “mode switch” of any “cable” whatsoever. Instead, the applied portions of Boggs states, at paragraphs 263-264 (emphasis added):

[0263] The present invention provides free port operation of the communications port, hereinafter ‘freeport’, that allows the user to control the port either manually or by operation of a user program. The procedure of freeport operation is shown in

PATENT**Application # 10/622,259****Attorney Docket # 2002P20760US01 (1009-029)**

FIG. 30a.

[0264] In the instant invention, the user implements free-port (step S3000) use by forcing **an interrupt (step S3002) of the PLC** according to the afore-described interrupt architecture. In this case, the user initiates freeport communication while operating the PLC in master mode by attaching an interrupt event that will pass control of **the communications port** to the user program (step S3004). This is performed while the system protocol holds the token (step S3006).

The present Office Action presents no evidence that the applied portions of Boggs teach any "mode switch" of any "cable" whatsoever. Thus, no evidence is presented that the applied portions of Boggs teach, "said programmable cable adapted to store" "a plurality of configuration parameters", that comprise "a mode switch parameter adapted to cause **a mode switch of said programmable cable** to select between a Freeport mode and a PPI mode".

The applied portions of Thomas fail to cure at least these deficiencies of the applied portions of Boggs.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

PATENT**Application # 10/622,259****Attorney Docket # 2002P20760US01 (1009-029)**

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of each rejection of each of claims 1-25 is respectfully requested.

2. Claims 26-32**a. Prima Facie Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Independent claim 26, from which each of claims 27-32 ultimately depends, states, *inter alia*, yet the applied portions of Boggs do not teach, “automatically communicating **from the programmable cable** to the network communications device a PIN number and at least one of a plurality of configuration parameters, the plurality of configuration parameters comprising a **mode switch parameter** adapted to cause a mode switch of said programmable cable to select between a Freeport mode and a PPI mode”. The applied portions of Boggs do not teach, “communicating” any “mode switch parameter” from any “cable” whatsoever. Instead, the applied portions of Boggs states, at paragraphs 263-264 (emphasis added):

[0263] The present invention provides free port operation **of the communications port**, hereinafter ‘freeport’, that allows the user to control the port either manually or by operation of a user program. The procedure of freeport operation is shown in FIG. 30a.

[0264] In the instant invention, the user implements free-port (step S3000) use by forcing **an interrupt (step S3002) of the PLC** according to the afore-described interrupt architecture. In this case, the user initiates freeport communication while operating the PLC in master mode by attaching an interrupt event that will pass

PATENT

Application # 10/622,259

Attorney Docket # 2002P20760US01 (1009-029)

control of the communications port to the user program (step S3004). This is performed while the system protocol holds the token (step S3006).

The present Office Action presents no evidence that the applied portions of Boggs teach, "communicating" any "mode switch parameter" from any "cable" at all. Thus, no evidence is presented that the applied portions of Boggs teach, "automatically communicating from the programmable cable to the network communications device a PIN number and at least one of a plurality of configuration parameters, the plurality of configuration parameters comprising a mode switch parameter adapted to cause a mode switch of said programmable cable to select between a Freeport mode and a PPI mode".

The applied portions of Thomas fail to cure at least these deficiencies of the applied portions of Boggs.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

PATENT

Application # 10/622,259

Attorney Docket # 2002P20760US01 (1009-029)

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of each rejection of each of claims 26-32 is respectfully requested.

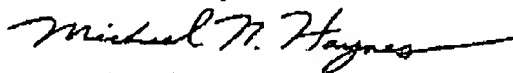
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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